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Remarks:

Amendments to the claims:

Claims 1 and 4-7 are pending in this application. By this Amendment, claim 1 is amended to address the rejection under 35 USC 112, second paragraph.

No new matter is added to the application by this Amendment.

Regarding the rejection of claim 1 and 4-7 under 35 USC 112, second paragraph:

The Patent Office alleges that claim 1 is indefinite because 1-20 C for R1 R2 are claimed, but the compounds specified have 1-5 C, no cycloaliphatic residue, and only N as heteroatoms. Applicant traverses this rejection. In view of the amendments to claim 1, Applicant submits that claim 1 is definite and that this rejection is moot.

Applicants respectfully request withdrawal of this rejection to the claims.

Regarding the rejection of claim 1 and 4-7 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being unpatentable over DE 1792331 (hereinafter "DE 331"):

Applicant traverses the Examiner's rejection of claims 1 and 4-7 as allegedly being anticipated by or, in the alternative, as allegedly being unpatentable over DE 331.

Prior to discussing the relative merits of the Examiner's rejection, the applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in

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the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

The undersigned also reminds the Patent Office that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John*

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Deere Co., 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

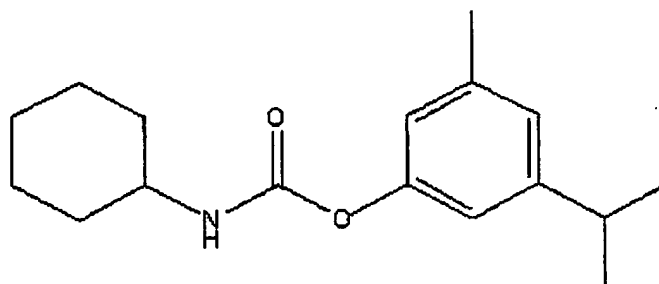
A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

The Patent Office alleges that DE 331 teaches or suggests each and every feature of claims 1 and 4-7. Specifically, the Patent Office alleges that Applicant's first compound on page 15 of the present application is taught by Compound #1 in Table 1 of DE 331 which is a methylcarbamate with a CAS # of 50934-64-0. Applicant respectfully disagrees with the allegations by the Patent Office.

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Compound #1 in Table 1 of DE 331 is:



3-methyl-5-isopropylphenyl-N-cyclohexyl carbamate

Additionally, CAS # 50934-64-0 is not directed a compound as required by amended claim 1. Instead, CAS # 50934-64-0 refers to a mixture and not a compound.

Moreover, not only does DE 331 fail to teach the presently claimed compound, but DE 331 actually teaches that the Compound #1, cited by the Patent Office, fails to work and is ineffective because Table 1 is clearly entitled "Ineffective carbamic acid esters". To be effective, Compound #1 and the other compounds in Table 1 of DE 331 must be combined with 1-naphthyl-N-methyl-carbamate (see page 5 of DE 331).

Thus, Applicant submits that DE 331 fails to teach or suggest a method for repelling cockroaches having the steps of providing a compound selected from the group consisting of methyl-carbamic acid (-)-menthyl ester, ethyl-carbamic acid (-)-menthyl ester, butyl-carbamic acid (-)-menthyl ester, isobutyl-carbamic acid (-)-menthyl ester, diethyl-carbamic acid (-)-menthyl ester, piperidine-1-carboxylic acid (-)-menthyl ester, morpholine-4-carboxylic acid (-)-menthyl ester, phenyl-carbamic acid (-)-menthyl ester and 3-[(-)-menthoxy-carbonylamino]-propionic acid ester, and applying a preparation comprising the compound to a substrate as recited in claim 1.

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Because the features of independent claim 1 are neither taught nor suggested by DE 331, DE 331 cannot anticipate, and would not have rendered obvious, the features specifically defined in amended claim 1.

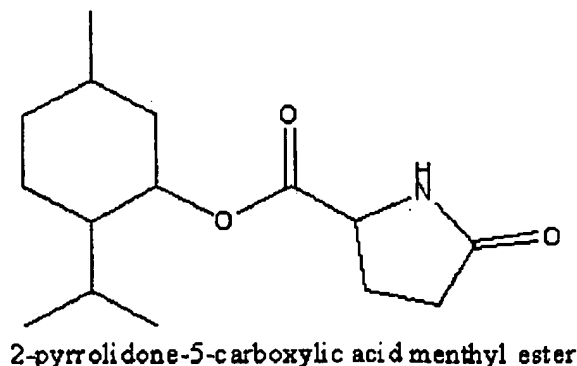
For at least these reasons, claims 1 and 4-7 are patentably distinct from and/or non-obvious in view of DE 331. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b)/103(a) are respectfully requested.

Regarding the rejection of claim 1 and 4-7 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being unpatentable over WO 00/16738 to Watkins et al. (hereinafter "Watkins"):

Applicant traverses the Examiner's rejection of claims 1 and 4-7 as allegedly being anticipated by or, in the alternative, as allegedly being unpatentable over Watkins.

The Patent Office alleges that Watkins teaches or suggests each and every feature of claims 1 and 4-7. Specifically, the Patent Office alleges that Watkins shows the instant compound, as claimed as a cycloaliphatic residue with hereto, and DEET applied in compositions with fragrances and insecticides, terpineol and rosemary oil. Applicant respectfully disagrees with the allegations by the Patent Office.

Watkins is directed to following compound:



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However, Watkins' 2-pyrrolidone-5-carboxylic acid menthyl ester has a structure which is fundamentally different from the presently claimed compound and does not teach or suggest the features of claim 1.

Thus, Watkins fails to teach or suggest the step of providing a compound selected from the group consisting of methyl-carbamic acid (-)-menthyl ester, ethyl-carbamic acid (-)-menthyl ester, butyl-carbamic acid (-)-menthyl ester, isobutyl-carbamic acid (-)-menthyl ester, diethyl-carbamic acid (-)-menthyl ester, piperidine-1-carboxylic acid (-)-menthyl ester, morpholine-4-carboxylic acid (-)-menthyl ester, phenyl-carbamic acid (-)-menthyl ester and 3-[(-)-menthoxy-carbonylamino]-propionic acid ester as recited in Claim 1.

Because the features of independent claim 1 are neither taught nor suggested by Watkins, Watkins cannot anticipate, and would not have rendered obvious, the features specifically defined in amended claim 1.

For at least these reasons, claims 1 and 4-7 are patentably distinct from and/or non-obvious in view of Watkins. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. 102(b)/103(a) are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.